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In re Application of
BIESCHKE et al.
Application No.: 10/089,233
PCT No.: PCT/EP00/09468
Int. Filing Date: 28 September 2000
Priority Date: 28 September 1999
Attorney Docket No.: P67758US0
For: QUANTITATIVE ANALYSIS AND
TIPIIFICATION OF SUBCELLULAR
PARTICLES

DECISION ON REQUEST
UNDER 37 CFR 1.497(d)

This is a decision on applicants' "Response" to Notification of Defective Response, treated as a request under 37 CFR 1.497(d) filed on 06 March 2003 in the United States Patent and Trademark Office (USPTO). Petitioner seeks to add Manfred Eigen and Hans A. Kretzschmar as inventors in the above referenced application. The requisite \$130 fee will be charged to applicant's deposit account per their authorization. The \$130 surcharge for filing the declaration after the 30 month period was paid. Since a declaration in compliance with 37 CFR 1.497 was not presented with applicant's Response to the Notification of Defective Response, the application is **ABANDONED**.

BACKGROUND

On 19 June 2002, a Notification of Missing Requirements was mailed to applicants, indicating that an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b) was required.

On 19 December 2002, in response to the Notification of Missing Requirements, applicants filed a request for a four month extension of time and an executed declaration, identifying PCT/EP00/09468. The declaration named Jan Bieschke, Armin Giese, Manfred Eigen as inventive entities. A second page listed only Hans A. Kretzschmar as an inventive entity. The declaration was executed by the inventors named in the international application publication and by Messrs. Eigen and Kretzschmar, who were not named as inventors in the published international application.

On 06 February 2003, a Notification of Defective Response was mailed to applicants indicating that the declaration executed by the inventors did not comply with 37 CFR 1.497(a) and (b). The deadline for responding was one month from the mail date of the Notification (or by 06 March 2003) or within the time remaining in the response set forth in the Notification of Missing Requirements, whichever was longer. The only extensions of time available were those under the Notification of Missing Requirements.

On 06 March 2003, Petitioner filed a response, treated as a request to correct inventorship under 37 CFR 1.497(d), to add inventors Manfred Eigen and Hans A. Kretzschmar. Petitioner provided statements of Messrs. Eigen and Kretzschmar in support of the correction of inventorship under 37 CFR 1.497(d) and the apparent written consent of the assignee. However, Petitioner did not provide a new declaration in compliance with 37 CFR 1.497.

DISCUSSION

The executed declaration submitted on 19 December 2002 appears to be two incomplete declarations and possibly a third complete declaration. Inventor Bieschke signed one declaration, Inventor Giese signed a second declaration, Manfred Eigen signed a third declaration to which Hans Kretzschmar executed page 2 (identified as Page 4 of 4).

Section 201.03 of the MPEP states in pertinent part,:

An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration. For example, where the inventive entity is A and B, a declaration may not be executed only by A naming only A as the inventor and a different declaration may not be executed only by B naming only B as the inventor, which two declarations are then combined into one declaration with a first page of boiler plate, a second page with A's signature, and a second page with B's signature (so that it appears that the declaration was executed with the entire inventive entity appearing in the declaration when it did not).

(Emphasis added.)

Petitioner submitted at least two incomplete declarations. The third declaration appears to have two sheets, the second sheet bearing the signature of Hans Kretzschmar. The declarations do not meet the requirements of 37 CFR 1.497(a); that is, the declarations do not identify all the inventors. What is required is one declaration which identifies all inventors. Since the declarations submitted do not identify all inventors, the requirements of 37 CFR 1.497 (a) and (b) have not been met and the declarations are unacceptable as filed. Because a declaration in compliance with 37 CFR 1.497 was not presented as a Response to the Notification of Defective Response, the application is abandoned.

Where the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and 37 CFR 1.497(d) names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship occurred without deceptive intention on his or her part; (2) the fee set forth in § 1.17(i); and (3) written consent of the assignee, if an assignment has been executed by any of the original named inventors.

Pursuant to 35 U.S.C. 371(c)(4) and 37 CFR 1.497(d), the written consent of the assignee is required to correct the inventorship. *See MPEP 201.03 D. Written Consent of Assignee.* As stated in MPEP §201.03 (Rev. Feb. 2003, p.200-8), the individual signing on behalf of the

assignee giving its consent to the requested inventorship correction, should specifically state that he or she has the authority to act on behalf of the assignee. In the absence of such a statement, the consent will be accepted if it is signed by an appropriate official of the assignee (e.g., president, vice president, secretary, treasurer, or derivative thereof) if the official's title has been made of record. A general statement of authority to act for the assignee, or on the specific matter of consent, or the appropriate title of the party signing on behalf of the assignee should be made of record in the consent.


Here, the Consent of Assignee does not satisfy 37 CFR 1.497. The Consent of Assignee appeared to be executed by Dr. M. Leimkuhler, identified as "Head of I.P." and Christian V. Spiegel, identified as "Head of Legal" on behalf of Evotec OAI AG. The individuals who signed on behalf of the respective assignee did not specifically state that he or she had the authority to act on behalf of the assignee. In the absence of such a statement, the consent will be accepted if it is signed by an appropriate official of the assignee (e.g., president, vice president, secretary, treasurer, or derivative thereof) if the official's title has been made of record.

Furthermore, the Consent indicates that a copy of the respective assignment was attached; however, only a copy of the assignment executed by the inventor to be added is located. Copies of the respective assignments are not found among the papers submitted. Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment submitted for recording) or by specifying (e.g., reel and frame number) where such evidence is recorded in the Office is required. The submission establishing ownership must be signed by a party authorized to act on behalf of the assignee. See 37 CFR 3.73. Therefore, applicant has not met all of the requirements under 37 CFR 1.497(d) for correction of inventorship.

CONCLUSION

The request under 37 CFR 1.497(d) is **DISMISSED WITHOUT PREJUDICE**. The application is **ABANDONED**. Should applicant file a petition to revive under 37 CFR 1.137, the proper reply is a new declaration executed by all the inventors accompanied by satisfaction of the requirements of 37 CFR 1.497(d).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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